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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,005	03/29/2001	Michael D. Ellis	UVV/189	8533
1473	7590	09/08/2005	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			FISH, JAMIESON W	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,005

Applicant(s)

ELLIS ET AL.

Examiner

Jamieson W. Fish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35,38-45 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-17,24-30,33-35, 38-45 and 52-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 06-27-2005 have been fully considered but they are not persuasive. The applicants argue, 1. "Inoue does not show or suggest applicants' feature of 'determining predicted time change information associated with the program, wherein the predicted time change information is based on previous programs' (See Remarks Pg 10 Paragraph 4)." Further applicants submit that 2. Statements in the Office Action regarding predicted time change and actual time change are contradictory (See Pg. 11 Paragraph 2). The examiner respectfully disagrees.

With respect to argument 2: The examiner agrees that ultimately a time change can only be an actual or a predicted time change. However, this is not in contradiction with the Inoue's service additional information disclosed in the Office Action. The determination of whether a time change is an actual or a predicted time change occurs when a program airs. Thus, service additional information specifying the start time of a program, received before the start of program may become a predicted time change if the service information is inaccurate or replaced by new service additional information that specifies an updated start time. The service additional information may also become an actual time change if the program actually starts at the time specified in the service information. An example clearly illustrating this principle is a sporting event that goes into overtime. Upon going into the first overtime, service additional information ABC is received that specifies that program X, a program intended to be broadcast after the completion of the sporting event, will be delayed a half an hour due to the first

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overtime delaying the end time of the sporting event. If the sporting event is complete at the end of the first overtime and program X is broadcast at the time indicated in service additional information ABC, service additional information ABC becomes an actual time change. However, if the sporting were to go into a second overtime and the start time of program X was further delayed beyond the start time specified in service additional information ABC, service additional information ABC becomes a predicted time change.

With respect to argument 1: Inoue does teach determining predicted time change information associated with the program, wherein the predicted time change information is based on previous programs. Inoue teaches where a broadcast time of a program (Baseball) is extended (See Fig. 6A and B Col. 8 lines 32-67). Such an extension changes the start time the following program (Drama: Detective 0) which changes the start time of the following program (News). It is clear that if the user had chosen to record News instead of Jurassic Land, which is in the realm of the invention since the recording of Jurassic Land is only one example of how the invention works, then the start time (predicted time change) of News would be based on previous programs.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-2, 5-7, 10-17, 24-26, 29-30, 33-35, 38-45, 52-54, and 57-58** are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al. (US 6,185,360).
3. Regarding claim **1**, Inoue teaches a method for use in a recording system for reducing cut-offs when programs are recorded, comprising: receiving an indication from a user to select a program to record (See Fig. 11 B Step 4); determining predicted time change information associated with the program, wherein the predicted time change information is based on previous programs (See Discussion of argument 1 above); (See Fig. 11C Step 8 and Col. 8 lines 32-67); and recording the program to compensate for a time change based on the predicted time change information (See Fig. 11C and Step 11 and Col. 8 lines 32-67).
4. Regarding claim **2**, Inoue teaches wherein the predicted time change information comprises predicted time delay information (See Col. 1 lines 8-15).
5. Regarding claim **5**, Inoue teaches wherein the predicted time delay information is based on previously logged time changes (See Fig. 11C Step 8, 11 and Col. 1 lines 14-30 Col. 8 lines 32-59. Service information about a program change stored in memory before the broadcast of the program is a previously logged time change).
6. Regarding claim **6**, Inoue teaches further comprising displaying a predicted time delay information for the program (See Fig. 11C Step 11 and Col. 8 lines 46-59. Changing EPG is displaying time delay information).

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7. Regarding claim **7**, Inoue teaches wherein the predicted time change information comprises predicted time extension information (See Fig. 6A-B and Col. 8 lines 32-46).

8. Regarding claim **10**, Inoue teaches wherein the predicted time extension information is based on previously logged time changes (See Fig. 6A-B and Col. 8 lines 32-46 Time extension information stored in memory up until the completion of the baseball game is a previously logged time change).

9. Regarding claim **11**, Inoue teaches further comprising displaying a predicted time extension information for the program (See Fig. 6A-B, Fig. 11C Step 11, and Col. 8 lines 32-46).

10. Regarding claim **12**, Inoue further teaches providing a user with an opportunity to select a recording start time (See Col. 3 lines 28-33 Recording a program directly is selecting a recording start time).

11. Regarding claim **13**, Inoue further teaches automatically selecting the recording start time (See Col. 3 lines 28-33 automatically recording a desired program includes automatically selecting the recording start time).

12. Regarding claim **14**, Inoue further teaches providing a user with an opportunity to select to have automatic selection of the recording start time (See Col. 3 lines 28-32).

13. Regarding claim **15**, Inoue further teaches providing a user with an opportunity to select a recording end time (See Col. 3 lines 28-33 Recording a program directly is selecting a recording end time).

14. Regarding claim **16**, Inoue further teaches automatically selecting the recording end time (See Col. 3 lines 28-33 automatically recording a desired program includes automatically selecting the recording end time).

15. Regarding claim **17**, Inoue further teaches providing a user with an opportunity to select to have automatic selection of the recording end time (See Col. 3 lines 28-33).

16. Regarding claim **24**, Inoue further teaches displaying an icon in a program listing for the program to indicate that predicted time change information is available (See Fig. 6B Extending Baseball rectangle).

17. Regarding claim **25**, Inoue further teaches displaying an icon in a program listing for that program that indicates the program is to be recorded (See Col. 7 lines 60-65).

18. Regarding claim **26**, Inoue further teaches trimming a recording time of the scheduled program or an adjacent program to reduce the cut-off in a program recording (See Fig. 6A-B, Col. 8 lines 20-25, 32-67, and Col. 9 lines 1-35 If overlap is detected a decision is made as to which program is to be recorded. Fig. 6A shows the original recording schedule with the shaded regions showing the programs to be recorded. Fig. 6B shows the modified recording schedule where the recording of Jurassic Land is trimmed to reduce the cut-off in the program recording of Baseball).

19. Regarding claim **29**, Inoue teaches a recording system that reduces cut-offs when programs are recorded (See Fig. 1 and Col. 1 lines 60-67 Col. 2 lines 1-60), comprising: control circuitry that is configured to: receive an indication from a user to select a program to record; and determine predicted time change information associated with the program, (See Fig. 2 Input and output information controller CPU

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23a and Col. 1 lines 60-67 Col. 2 lines 1-60) wherein the predicted time change information change information is based on previous programs (See Discussion of argument 1 above); and a media recording device that is responsive to the control circuitry and that is configured to record the program to compensate for a time change based on the predicted time change information (See Fig. 1 Second Memory Unit 26 and Col. 1 lines 60-67 Col. 2 lines 1-60).

20. Regarding claims **30, 33-35, 38-45, 52-54**, claims **30, 33-35, 38-45, 52-54** are functions performed by the apparatus of claim 29 related to method claims 2, 5-7, 10-17, 24-26, respectively. Therefore, claims **30, 33-35, 38-45, 52-54** are analyzed and rejected according to claims 2, 5-7, 10-17, 24-26.

21. Regarding claim **57**, Inoue teaches allowing the user to change the predicted time change information (See Col. 7 lines 32-48 In Inoue, as interpreted in Response to Arguments above, service additional information is predicted time change information. The user can change which service additional information used to construct the EPG. Thus, the user can change predicted time change information).

22. Regarding claim **58**, claim **58** is an apparatus claim 29 related to method claim 57. Therefore, claims **58** is analyzed and rejected according to method claim 57.

### ***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



24. Claims **27-28** and **55-56** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al.

25. Regarding claim **27**, Inoue teaches wherein trimming the recording comprises trimming based on a confidence level in user's preferred programming for the scheduled program and the adjacent program (See Fig. 15 Step 42 Col. 17 lines 36-67, Col. 18 1-6 and Col. 19 lines 8-20). Establishing a confidence level based on user preferred programming is different than establishing a confidence level based on time change information. However, both methods of establishing a confidence level are similar in that both methods rely on previously logged data. Inoue also teaches various types of information including information about program distribution time can be used to decide which program is trimmed (See Col. 1 lines 22-30, Col. 9 lines 1-36, and Col. 11 lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Inoue's method of determining which program is trimmed based on a confidence level in time change information for the scheduled and the adjacent program in order to provide Inoue's method an alternate way of automatically choosing which program to trim (See Col. 2 lines 16-25).

26. Regarding claim **28**, Inoue teaches wherein trimming comprises trimming a time changed recording time of the scheduled program when time change information for the scheduled program has a lower confidence level than the adjacent program (See Col. 9 lines 1-22 Either program can be trimmed).

Regarding claims **55-56**, claims 55-56 are functions performed by the apparatus of claim 29 related to method claims 27-28, respectively. Therefore, claims **55-56** are analyzed and rejected according to claims 27-28.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 9-02-2005



NGOC-YEN VU  
PRIMARY EXAMINER